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In re Application of:	:	
JARVINEN, Pekka, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/532,764	:	37 CFR 1.47(a)
PCT No.: PCT/FI2003/000807	:	
International Filing Date: 31 October 2003	:	
Priority Date: 01 November 2002	:	
Attorney's Docket No.: LA-7673-101US	:	
For: IMPLEMENTING A SERVICE,	:	
PARTICULARLY A FINANCIAL	:	
SERVICE, IN A NETWORK	:	
INVOLVING MOBILE TERMINALS	:	

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed 30 May 2006. Applicant has paid the required petition fee.

BACKGROUND

On 31 October 2003, applicants filed international application PCT/FI2003/000807. The application claimed a priority date of 01 November 2002, and it designated the United States. On 13 May 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 01 May 2005.

On 26 April 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 01 December 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 13 January 2006, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge and a declaration executed by four of the five inventors (the declaration was executed on behalf of the fifth inventor, Sirpa M. LIUKKONEN, by the CEO of the assignee, Meridea Financial Software OY).

On 07 March 2006, the DO/EO/US mailed a "Notification Of Defective Response" (PCT/DO/EO/916) indicating the declaration filed 13 January 2006 was defective in that it was not properly executed by inventor Sirpa M. LIUKKONEN.

On 30 May 2006, applicants filed a response to the Notification Of Defective Response (with required four-month extension fee) that included the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Sirpa M. LIUKKONEN.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have submitted the required petition fee, and the petition expressly states the last known addresses of the nonsigning inventors. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by four of the five inventors and on behalf of the remaining inventor, Sirpa M. LIUKKONEN, by the assignee. Because the assignee has executed the declaration on behalf of the non-signing inventor, the declaration cannot be treated as having been signed by the available inventors on their own behalf and on behalf of the non-signing inventor, as required for the declaration to be accepted.¹ The present declaration is therefore unacceptable. Item (3) is not satisfied.

Regarding item (4), the petition is somewhat ambiguous as to whether the inventor has refused to execute the application or whether the inventor cannot be located after diligent effort (the petition states that the inventor "has refused to sign the declaration;" however, the evidentiary statement filed with the petition refers to a "diligent effort to reach [the inventor] without success"). As discussed below, the materials provided are insufficient to adequately support either assertion.

¹ Where, as here, some of the inventors have executed the declaration, it is impermissible for the assignee to sign on behalf of an inventor. The assignee can only sign on behalf of the non-signing inventor(s) in cases where none of the inventors has signed the declaration (see 37 CFR 1.47(b)).

Where it is asserted that an inventor has refused to execute the application papers, section 409.03(d) of the MPEP states that a “copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also requires “a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.” Here, applicants have submitted a statement from Kelly LUOSTARINEN and three exhibits as evidence of the efforts made to obtain the signature of the nonsigning inventor. Ms. LUOSTARINEN states that she “tried to contact Mrs. Liukkonen a number of times by phone, post, emails and through her ex-coworker for requesting her signature, but without any response whatsoever,” going on to note that “our diligent effort to reach her” was unsuccessful. The exhibits provided are: (1) a letter from Ms. LUOSTARINEN to the nonsigning inventor requesting her signature and stating that it is accompanied by a copy of the complete application; and (2) copies of two emails from Ms. LUOSTARINEN to the nonsigning inventor, also requesting her signature. However, Ms. LUOSTARINEN does not refer to these exhibits in her statement. Accordingly, applicants have not provided the required firsthand authentication that the letter (with a copy of the complete application papers, as required) or the emails were in fact sent to the nonsigning inventor. Moreover, even if the sending of these communications is authenticated, no evidence has been provided to confirm that the inventor has received the communications (i.e., certified mail receipts bearing the inventor's signature, etc.) or that the address being used is correct. An inventor's failure to respond to requests for signature can only be treated as a refusal to sign if evidence is provided that the communications requesting the inventor's signature have been properly directed to the inventor. Based on the above, additional materials are required before it can be concluded that the inventor has been provided with a copy of the complete application papers and has refused to execute the application.

If, in the alternative, applicants are asserting that the inventor cannot be located after diligent effort, then applicants must satisfy the requirements set forth in MPEP § 409.03(d) with respect to such circumstances:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Applicants here have not provided a firsthand statement setting forth the specific efforts made to locate the nonsigning inventor. It is noted that any diligent effort should include, but not be limited to, an internet search (with the results of such search being included with any subsequent submission)

Because the present record is not sufficient to demonstrate either that the nonsigning inventor has refused to execute the application or that the inventor cannot be reached or located after diligent effort, item (4) of a grantable petition has not been satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (3) and (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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